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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application of:

**BILL L. DAVIS and JESSE S. WILLIAMSON**

For Reissue of U. S. Patent 5,630,363  
Issued May 20, 1997  
Serial No. 08/515,097

Group Art Unit: 2854

Filing Date: May 20, 1999

Examiner: S. Funk  
J. Hiltzen

Serial No.: ✓ 09/315,796

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LETTER

TO: The Honorable Commissioner  
of Patents and Trademarks  
Washington, D.C. 20231

SIR:

Pursuant to provisions of 37 CFR §1.56(a), reissue applicants disclose responses to interrogatories recently received by their assignee, Williamson Printing Corporation from Protestors (DeMoore and Printing Research, Inc. ("PRI") hereinafter "Protestors" or "Protestors/Plaintiffs") served in the litigation (Exhibit "A" hereto) between the parties, styled *Printing Research, Inc. and Howard W. DeMoore v. Williamson Printing Corporation, Bill L. Davis and Jesse S. Williamson*, (Civ. Act. No. 3-99CV1154-M (N.D. Tex. May 20, 1999).

I.

**The Answers to the Interrogatories  
Propounded Show the Weaknesses in Protestors' Position**

Protestors/Plaintiffs' interrogatory answers are, to say the least, unsupportive of their position that DeMoore is the first true inventor of the '363 patent.

First, the response to Interrogatory No. 1 indicates that DeMoore has weak, if any document support for a position that "By or about December 3, 1994, and perhaps earlier, Howard DeMoore had conceived of the invention." (p. 5, lines 4-5).

Second, DeMoore now vacillates on what his position on inventorship is, (1) himself alone (the position in Plaintiffs' Complaint in the litigation), or (2) himself with one or more of John Bird, Jesse Williamson and Bill Davis.

Third, DeMoore identifies in the same interrogatory response PRI former employees John Bird and Steve Garner as witnesses. Reissue Applicants submitted on March 1, 2000, inter alia, their MEMORANDUM CONCERNING THE PRIOR ART AND THEIR POSITION ON PATENTABILITY ("MEMORANDUM"), and included the affidavits of Bird (Exhibit B and D thereto) and Garner (Exhibit E thereto), which do not support DeMoore's position.

It is noted Protestors/Plaintiffs' interrogatory answers dated April 19, 2000 were executed over a week after Protestors/Plaintiffs were served with Reissue Applicants' MEMORANDUM mailed April 7, 2000.

Protestors/Plaintiffs failure to comment on the two Bird, Baker or Garner affidavit testimonies submitted with the MEMORANDUM is noteworthy. Those affidavit testimonies point to (1) a much earlier conception by Reissue Applicants than any date mentioned in the interrogatory response, (2) confidential information transfer about the '363 invention from Reissue Applicants to Steve Baker and John Bird of PRI starting in the summer of 1994, (3) directives from Reissue Applicants to DeMoore's subordinates in the late summer/fall of 1994 to achieve the necessary "iron" to carry out Reissue Applicants' process, and (4) derivation by DeMoore and PRI from Reissue Applicants of Reissue Applicants' claimed process via Baker and Bird. All of (1)-(4), coupled with Protestors' failure to date to submit sworn testimony from their witnesses and their documents calls for the examiner to draw negative inferences unfavorable to Protestors over the inventorship and derivation issues.

The Examiner is requested to read the interrogatory answers, and if he deems fit and it is possible, submit a "Requirement for Information" to Protestors in view of their charge of wrongful inventorship.

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II.

**Protestors/Plaintiffs So Far Refuse to Disclose  
Documents to the PTO to Support Their Position**

No documents have yet been produced by Protestors/Plaintiffs in response to a document request served at the same time as the interrogatories, as Protestor and assignee of reissue applicants are negotiating the terms of a proposed protective order. Reissue Applicants are taking the position in front of the Northern District of Texas that the petition to expunge process under 37 C.F.R. §1.59(b) and M.P.E.P. §§724.02 and 724.05 will protect the confidentiality of all of those non-material portions of the parties' documents, and only the material portions will be published with the file history of the reissue patent to issue. Protestors apparently question the PTO's ability (1) to make competent findings concerning inventorship/derivation and (2) to protect the confidentiality of the non-material portions of their documents.

Reissue Applicants are indeed desirous of submitting some/all documents produced in the litigation by Protestors/Plaintiffs **under one or more petitions to expunge**. Reissue Applicants submitted through their litigation counsel, on April 5, 2000, a letter to Protestors/Plaintiffs with a draft protective order permitting discovery materials to be filed in the PTO proceedings (Group Exhibit "B").

Protestors/Plaintiffs objected (Exhibit "C"), stating that "plaintiffs [/protestors] cannot accept the revisions to paragraph 7 that would allow Defendants to use Plaintiffs' Confidential Information before the Patent and Trademark Office", stating three reasons:

"First, the issuance and reaffirmation or confirmation of a patent confers a competitive and commercial advantage on the patent holder; therefore, using these documents before the PTO is use for a "business, competitive, or commercial purpose," which is exactly what the Protective Order is designed to prevent. Accordingly, adding this language is contradictory to both the word and the spirit of the Protective Order.

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"Second, a significant purpose of patent law is to open innovations and inventions to the public by allowing the inventor a limited period of exclusive use. Thus, the underlying philosophy of the patent office is (and should be) free access to information. Accordingly, there can hardly be a better way to assure that Confidential Information will become public knowledge than to use it before the PTO. Again, this is contrary to the purpose of the Protective Order.

"Third, in basic terms, Plaintiffs have accused Defendants of stealing Plaintiffs' idea. Now Defendants propose that Plaintiffs should agree to allow Defendants to use Plaintiffs' documents to defend that theft before the PTO. Plaintiffs consider such a proposal to be ill founded and without logical or equitable support. Presently, Plaintiffs consider this point non-negotiable." (Emphasis supplied)

Reissue Applicants believe Protestors' position is completely misfounded, if not totally ignorant of the law. Note Reissue Applicants' reply, Exhibit D.

Reissue Applicants believe that the Northern District of Texas will allow -- if not compel -- litigation counsel to forward documents received in the litigation to the undersigned counsel so that an evaluation can be made and compliance with 37 CFR §1.56(a) ensured.

Respectfully submitted,

  
Robert Hardy Falk  
Reg. No. 27,877

**FALK & FISH, L.L.P.**  
P.O. Box 794748  
Dallas, Texas 75397  
Telephone: (214) 954-4480  
Facsimile: (214) 969-5941

ATTORNEY FOR REISSUE APPLICANTS

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CERTIFICATE OF SERVICE

This is to certify that the foregoing Letter was served on Protestors'/Plaintiffs' counsel of record by placing a true and correct copy in the United States Mail, postage prepaid, on the 28th day of April, 2000, addressed as follows:

William D. Harris, Jr., Esq.  
Locke Liddell & Sapp LLP  
2200 Ross Avenue, Suite 2200  
Dallas, Texas 75201-6776



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